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Yasuhiro Shinkai

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05/31/2005

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EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/863,476

**Applicant(s)**

SHINKAI, YASUHIRO

**Examiner**

Tan Dean D. Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed 3/8/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- 1) in claim 1, "printed in color",
- 2) new claim 16 (part of 1),
- 3) new claim 17 (part of 1),

Applicant is required to 1) show the examiner the support of these new added material in the specification or 2) cancel the new matter in the reply to this Office Action. The examiner has reviewed the specification at least 2 times but could not find items listed in 1) – 3) above.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

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directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 10 (method<sup>1</sup>), 1-5, 16-17 (apparatus<sup>1</sup>) are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over OHTSUKA et al (US 6,788,425).**

**As for Independent method<sup>1</sup> claim 10**, OHTSUKA et al discloses a print order acceptance method for accepting an order for printing images on the basis of digital image data, comprising the steps of:

(a) transferring to a 1<sup>st</sup> printer (Fig. 1 (20)) ordered image data and order information, and

(b) instructing a 2<sup>nd</sup> printer (col. 4, lines 55-60) to print a voucher (receipt) including details of the order on the basis of the order information, {see Figs. 1, 3, 9, c4:55-67, c5:1-32, c9:50-67}. As for the new limitation of "prepared on the basis of high-precision image data" on the thumbnail images, this carries no patentable weight since the features of the images must be positively recited such as size, weight, shape, etc. and not how it's made. Furthermore, this is inherently included in the teaching of

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OHTSUKA et al since it uses the same well known print order reception system for confirming print order information. Alternatively, it would have been obvious to upgrade the print order reception system for confirming print order information to high-precision image data if necessary if higher precision image data is critical and cost is secondary to quality.

Alternatively, it would have been obvious to call the printer which prints the content of the print order information a voucher printer as mere using other equivalent term.

**As for independent apparatus<sup>1</sup> claim 1**, which is the apparatus to carry out the method of claim 10, the order acceptance machine is shown in Fig. 4 (or Fig. 3) wherein the image printer is element (20), the voucher printer is the printer that prints printout copy 15b and the ordering images and information are shown in Fig. 9. As for the new limitation of “printed in color” on the thumbnail images, which is merely thumbnail images printed parameter, this is inherently included in the teaching of OHTSUKA et al Fig. 2, line 9: “color conversion parameters: ...”. Alternatively, it would have been obvious to upgrade the print order reception system for confirming print order information (thumbnail images) printed in color if necessary if the color feature is critical for identification and cost is secondary to quality.

**\*<sup>1</sup> As for dep. claim 2 (part of 1)**, which deals with the intended use of the voucher, i.e. ascertaining printouts of images, this carries no patentable weight in an apparatus claim which only gives patentable weight to system structural elements or structures. Moreover, this is also taught in OHTSUKA et al Fig. 9.

**\*2 As for dep. claim 3** (part of 1), which deals with other elements of the print order acceptance system, i.e. means for displaying images, this is shown in Fig. 1 and 3 (12).

**\*3,4 As for dep. claims 4, 5** (part of 1), which deals with the type of images received and/or produced, i.e. thumbnail images, these are fairly taught in Fig. 9. Note also that the type of images received is non-essential to the scope of the claimed invention since it appears that it can receive any type of images.

**As for dep. claim 16** (part of 1), which deals with well known thumbnail images arranging parameter, i.e. in an index for easy viewing/confirming, this is inherently included or taught in Fig. 4, and 2 or would have been obvious to do so to improve viewing, confirming of the thumbnail images. Moreover, this limitation carries no patentable weight since it's not positively written "are arranged" for an apparatus claim. Note that in an apparatus, only features of an apparatus which may be recited either structurally or functionally or in other word, in term of structure rather than function, receives patentable weight. "An apparatus claims cover what a device is, not what a device does." See In re Hewlett-Packard Co. v. Bausch & Lomb, Inc. 909 F. 2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir 1990).

**As for dep. claim 17** (part of 1), which deals with well known voucher printer paper/sheet or medium type, a double weight glossy paper, this is non-essential to the scope of the claimed invention and is inherently included in the teaching of OHTSUKA et al since double weight glossy paper is normally used in photographic prints or pictures and would have been obvious to use similar type for quality and stability.

**5. Claim 18 rejected under 35 U.S.C. 103(a) as being unpatentable over OHTSUKA et al as applied to claims 1-5, 16-17 above, and further in view of RIFKIN or JP 1111 6908.**

RIFKIN is merely cited to teach well known practice of producing printed images upon a peel-off sticker bearing media on a sheet of paper wherein the sticker can be peeled-off for various desired purpose, making a personalizing item, i.e. bumper sticker, book sticker, etc. {see col. 1, lines 32-52, col. 2, lines 1-5}. It would have been obvious to modify the teaching of OHTSUKA et al by printing the voucher on a medium comprising a peel-off sticker as taught by RIFKIN for the benefit of making a personalizing item, i.e. bumper sticker, as indicated above.

JP 1111 6908 is merely cited to teach well known practice of producing printed images upon a peel-off sticker bearing media on a sheet of paper wherein the sticker can be peeled-off for various desired purpose, delivery voucher or sticker {see novelty, use}. It would have been obvious to modify the teaching of OHTSUKA et al by printing the voucher on a medium comprising a peel-off sticker as taught by JP 1111 6908 for use as delivery voucher or sticker.

**6. Claims 11, 13, 6-9, 12-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over OHTSUKA et al in view of SPARKS et al (US 6,167,382).**

**As for Independent method<sup>2</sup> 11,** OHTSUKA et al discloses a print order acceptance method for accepting an order for printing images on the basis of digital image data, comprising the steps of:

(a) transferring to a 1<sup>st</sup> printer (Fig. 1, (20)) ordered image data and order information, and

(b) transmitting, to a person who has placed the order, thumbnail images corresponding to image data which have been transferred to the image printer and the order information (or confirming the contents of the order) {see c20:32-60}. As for the new limitation of “prepared on the basis of high-precision image data” on the thumbnail images, this carries no patentable weight since the features of the images must be positively recited such as size, weight, shape, etc. and not how it's made. Furthermore, this is inherently included in the teaching of OHTSUKA et al since it uses the same well known print order reception system for confirming print order information. Alternatively, it would have been obvious to upgrade the print order reception system for confirming print order information to high-precision image data if necessary if higher precision image data is critical and cost is secondary to quality.

Therefore, OHTSUKA et al discloses the claimed invention except for carrying out the communication or informing of step (b) in the form of an electronic mail or the type of transmission, by electronic mail.

In a similar image printing network system, SPARKS et al is cited to teach well known practice of communicating/transmitting with the customer ordering confirmation using electronic means, i.e. e-mail {see Fig. 9, 49-53, especially Figs. 59-62, col. 1 or 2, abstract}. It would have been obvious to modify the transmitting of step (b) of OHTSUKA et al by using well known global computer network system, i.e. Internet with



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email capacity, to allow effective communication and remote order as taught by SPARKS et al above.

**\*<sup>1</sup> As for dep. claim 13** (part of 11) which deals with how the ordering step is carried out, i.e., by e-mail and at a designated address, see SPARKS et al Figs. 59-62.

**As for independent apparatus<sup>2</sup> claim 6**, which is the apparatus to carry out the method of claim 10 above, the order acceptance machine is shown in Fig. 4 (or Fig. 12) wherein (a) the image printer is element (220 or 130), and (b) the electronic mail transmission means which communicates with the person who has placed an order and in the form of an electronic mail is shown in SPARKS et al described in the rejection of claim 1 above.

**\*<sup>1, 2, 3</sup> As for dep. claims 7, 8, 9** (part of 6), these are taught in the combination of OHTSUKA et al in view of SPARKS et al and in view of Figs. 1 and 9 of OHTSUKA et al and Figs. 59-62 of SPARKS et al.

**\*<sup>4</sup> As for dep. 12** (part of 6), this is taught in Figs. 59-62 of SPARKS et al.

**\*<sup>5</sup> As for dep. 15** (part of 6), the use of other access device by the client for portable convenience, i.e. cellular phone, would have been obvious as mere using other similar device to access the ordering system, absent evidence of unexpected results.

7. **Claims 10 (method<sup>1</sup>), 1-5, 14 (apparatus<sup>1</sup>), 11, 13 (method<sup>2</sup>), 6-9, 12 and 15 (apparatus<sup>2</sup>) are rejected (2<sup>nd</sup>) under 35 U.S.C. 103(a) as obvious over TAMURA et al (US 6,771,896).**

**As for Independent method<sup>1</sup> claim 10**, TAMURA et al discloses a print order acceptance method for accepting an order for printing images on the basis of digital image data, comprising the steps of:

(a) transferring to a 1<sup>st</sup> printer (130 or 220) ordered image data and order information, and

(b) instructing a 2<sup>nd</sup> printer (212) to print a voucher (receipt) including details of the order on the basis of the order information, {see Fig. 4, 12, 13(a), 13(b), col. 19, lines 40-67 (or c4;40-67), c20:1-50}. TAMURA et al discloses the claimed invention except for (b) printing a receipt including details of the order and thumbnail images corresponding to image data which has been transferred to the image printer.

However, on c20:32-49, TAMURA et al discloses the teaching of confirming the contents of the order by selecting a preview mode on the camera device which shows the thumbnail images corresponding to images for which prints are desired and the number of prints and displayed in the running state as shown in Figs. 13(a)-13(b), thus inherently preventing ordering errors. Therefore, it would have been obvious to modify the teachings of TAMURA et al above by including in (b) a printout of thumbnail images corresponding to images for which prints are desired and the number of prints as taught above if complete information of the order and print out copy are desired. As for the new limitation of "prepared on the basis of high-precision image data" on the thumbnail images, this carries no patentable weight since the features of the images must be positively recited such as size, weight, shape, etc. and not how it's made. Furthermore, this is inherently included in the teaching of OHTSUKA et al since it uses the same well

known print order reception system for confirming print order information. Alternatively, it would have been obvious to upgrade the print order reception system for confirming print order information to high-precision image data if necessary if higher precision image data is critical and cost is secondary to quality.

**As for independent apparatus<sup>1</sup> claim 1**, which is the apparatus to carry out the method of claim 10, the order acceptance machine is shown in Fig. 4 (or Fig. 12) wherein the image printer is element (220 or 130), the voucher printer is element 212 and wherein the motivation for printing the thumbnail images in the voucher is cited in claim 10 above. As for the new limitation of “printed in color” on the thumbnail images, which is merely thumbnail images printed parameter, this is inherently included in the teaching of OHTSUKA et al Fig. 2, line 9: “color conversion parameters: ...”. Alternatively, it would have been obvious to upgrade the print order reception system for confirming print order information (thumbnail images) printed in color if necessary if the color feature is critical for identification and cost is secondary to quality.

<sup>\*1</sup> **As for dep. claim 2** (part of 1), which deals with the intended use of the voucher, i.e. ascertaining printouts of images, this carries no patentable weight in an apparatus claim which only gives patentable weight to system structural elements or structures. Moreover, this is also taught in TAMURA et al as indicated in claim 10 above.

<sup>\*2</sup> **As for dep. claim 3** (part of 1), which deals with other elements of the print order acceptance system, i.e. means for displaying images, this is shown in Fig. 13 (a), 13 (b), and/or Fig. 4 (224).

\*3.4 **As for dep. claims 4, 5** (part of 1), which deals with the type of images received and/or produced, i.e. thumbnail images, these are fairly taught in Figs. 13(a), 13(b) or Fig. 12 or 9. Note also that the type of images received is non-essential to the scope of the claimed invention since it appears that it can receive any type of images.

**As for Independent method<sup>2</sup> 11**, TAMURA et al discloses a print order acceptance method for accepting an order for printing images on the basis of digital image data, comprising the steps of:

(a) transferring to a 1<sup>st</sup> printer (130 or 220) ordered image data and order information, and

(b) transmitting, to a person who has placed the order, thumbnail images corresponding to image data which have been transferred to the image printer and the order information (or confirming the contents of the order) {see c20:32-60}. TAMURA et al discloses the claimed invention except for carrying out the communication/informing of step (b) in the form of an electronic mail or the type of transmission, by electronic mail. However, on col. 13:10-12, TAMURA et al general discloses the communicating/informing of the user from the print order acceptance system by electronic mail, therefore, it would have been obvious to carry out the communication/informing of step (b) by email as mere applying similar teaching to other similar communication step to achieve similar results, absent evidence of unexpected results. As for the new limitation of "prepared on the basis of high-precision image data" on the thumbnail images, this carries no patentable weight since the features of the images must be positively recited such as size, weight, shape, etc. and not how it's

made. Furthermore, this is inherently included in the teaching of OHTSUKA et al since it uses the same well known print order reception system for confirming print order information. Alternatively, it would have been obvious to upgrade the print order reception system for confirming print order information to high-precision image data if necessary if higher precision image data is critical and cost is secondary to quality.

\*<sup>1</sup> **As for dep. claim 13** (part of 11) which deals with how the ordering step is carried out, i.e., by e-mail and at a designated address, in view of the general teaching of communicating/informing of the user from the print order acceptance system by electronic mail, therefore, it would have been obvious to apply the same method for placing order as mere applying similar teaching to other similar communication step to achieve similar results, absent evidence of unexpected results.

**As for independent apparatus<sup>2</sup> claim 6**, which is the apparatus to carry out the method of claim 10 above, the order acceptance machine is shown in Fig. 4 (or Fig. 12) wherein (a) the image printer is element (220 or 130), and (b) the electronic mail transmission means which communicates with the person who has placed an order and in the form of an electronic mail is shown described on col. 13, lines 10-13. As for the ordering in the form of an electronic mail, this is rejected for the same reason set forth in claims 10 and 13 above. As for the new limitation of "prepared on the basis of high-precision image data" on the thumbnail images, this carries no patentable weight since the features of the images must be positively recited such as size, weight, shape, etc. and not how it's made. Furthermore, this is inherently included in the teaching of OHTSUKA et al since it uses the same well known print order reception system for

confirming print order information. Alternatively, it would have been obvious to upgrade the print order reception system for confirming print order information to high-precision image data if necessary if higher precision image data is critical and cost is secondary to quality.

<sup>\*1, 2, 3</sup> **As for dep. claims 7, 8, 9** (part of 6), which have similar limitations as in dep. 3, 4, 5, above respectively, they are rejected for the same reasons set forth in claims 3, 4, 5 above.

<sup>\*4</sup> **As for dep. 12** (part of 6), which has similar limitations as in dep. 13 above, it's rejected for the same reasons set forth in dep. claim 13 above.

<sup>\*5</sup> **As for dep. 15** (part of 6), TAMURA et al discloses the communication with the user/client using portable cellular phone {see c9:47-50}. The use of other similar/equivalent portable phone for displaying images if desired would have been obvious as merely using other similar/equivalent device to achieve similar/equivalent results, absent evidence of unexpected results. Surely, an image display is normally better than a text/data display or would have been obvious if an image display is desired.

**8. Claim 15 is rejected (2<sup>nd</sup>) under 35 U.S.C. 103(a) as being unpatentable over TAMURA et al as applied to claims 6-9, 12 above, and further in view of CONE et al or NARAYANASWAMY et al.**

The teaching of TAMURA et al is cited above. TAMURA et al teaches the communication with the user/client using portable cellular phone {see c9:47-50}. CONE et al or NARAYANASWAMY et al is cited to teach the use of portable cellular phone

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with screen for viewing of virtual image of video information received via a wireless communication network {see CONE et al Fig. 1, or 2 or [0004, 0021], or NARAYANASWAMY et al Fig. 1A, 1B or Fig. 4, col. 2, lines 20-30}. It would have been obvious to modify the portable cordless phone of TAMURA et al by using portable cellular phone with screen for viewing of virtual image of video information received via a wireless communication network as taught by CONE et al or NARAYANASWAMY et al to allow viewing of virtual image of video information if desired.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection which are initiated by applicant's amendment.

No claims are allowed.



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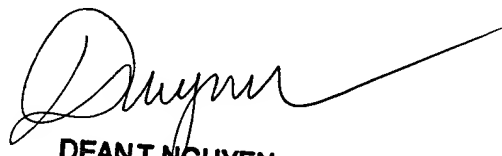
11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (571) 272-6812. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn  
May 25, 2005



DEAN T. NGUYEN  
PRIMARY EXAMINER